

See Paper  
No. 9

2134

PTO/SB/21 (08-03) (AW 10/2003)

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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 13

Application Number	10/066,901
Filing Date	February 4, 2002
First Named Inventor	Yoshiho Gotoh, et al.
Art Unit	2134
Examiner Name	Paul E. Callahan
Attorney Docket No.	MTS-710US26

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### ENCLOSURES (Check all that apply)

- Fee Transmittal Form
  - Fee Attached
- Amendment/Reply
  - After Final
  - Affidavits/Declaration(s)
- Extension of Time Request
- Express Abandonment Request
- Information Disclosure Statement
- Certified Copy of Priority Document(s)
- Response to Missing Parts/ Incomplete Application
  - Response to Missing Parts under 37 CFR 1.52 or 1.53

- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a Provisional Application
- Power of Attorney, Revocation, Change of Correspondence Address
- Terminal Disclaimer
- Request for Refund
- CD, Number of CD(s) \_\_\_\_\_

- After Allowance Communication to Group
- Appeal Communication to Board of Appeals and Interferences
- Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- Proprietary Information
- Status Letter
- Other Enclosure(s) (please identify below):  
Return Postcard

### Remarks:

### SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual	Lawrence E. Ashery	Registration No. (Attorney/Agent)	34,515
Signature			
Date	January 15, 2004		

### CERTIFICATE OF TRANSMISSION / MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date:

January 15, 2004

Name (Print/Type)	Lawrence E. Ashery		
Signature		Date	January 15, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.

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Reply to Office Communication Dated: January 12, 2004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. No: 10/066,901

Applicant: Y. Gotoh et al.

Filed: February 4, 2002

OPTICAL DISK, AN OPTICAL DISK BARCODE FORMING METHOD, AN OPTICAL DISK REPRODUCTION APPARATUS, A MARKING FORMING APPARATUS, A METHOD OF FORMING A LASER MARKING ON AN OPTICAL DISK, AND A METHOD OF MANUFACTURING AN OPTICAL DISK

TC/A.U.: 2134

Examiner: Paul E. Callahan

Confirmation No.: 5932

Docket No.: MTS-710US26

**PETITION UNDER 37 CFR 1.181 TO RESCIND ABANDONMENT**

Attention: Office of Petitions  
 Mail Stop Petition  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

A Notice of Abandonment dated January 12, 2004 (copy enclosed) was issued in error by the United States Patent and Trademark Office. This Petition is being filed to rescind the abandonment, return this application to pending status, and resume prosecution. The relevant facts are as follows:

(1) On September 22, 2003 an Amendment (copy enclosed) was filed with the United States Patent and Trademark Office in response to the June 20, 2003 Office Action as evidenced by the enclosed copy of the postcard date-stamped by the United States Patent and Trademark Office.

(2) On December 18, 2004, Applicants' Attorney's office called Examiner Paul Callahan to inquire as to the status of the September 22, 2003 Amendment. Examiner Callahan agreed to check into the status of the Amendment and report his findings to Applicants' Attorney's office.

(3) On December 19, 2004, Examiner Callahan called Applicants' Attorney's office and stated that he could find no record of the September 22, 2003 Amendment being entered

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Reply to Office Communication Dated: January 12, 2004

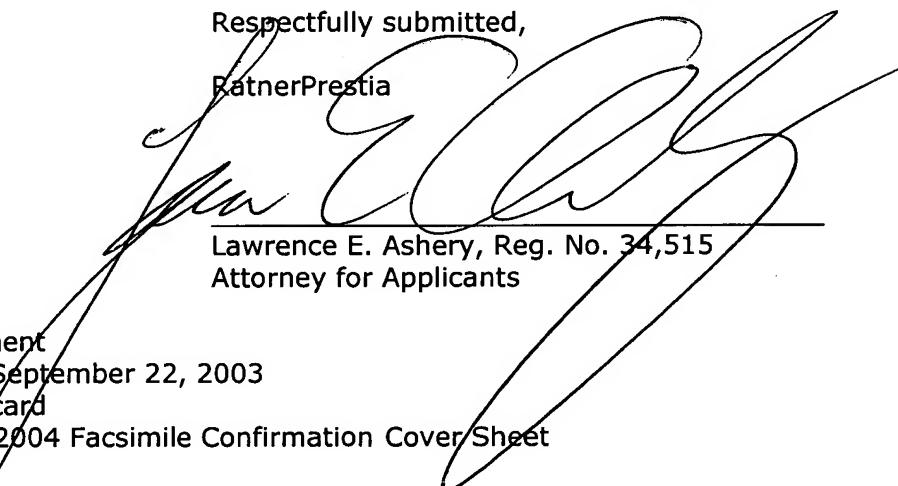
into the Patent Application Information Retrieval system of the United States Patent and Trademark Office.

(4) On January 8, 2004, Applicants' Attorney's office faxed a copy of the Amendment and accompanying papers filed on September 22, 2003 to the United States Patent and Trademark Office Centralized Fax location, as required by the December 1, 2003 Centralized Delivery and Facsimile Transmission Requirements For Patent Application Related Correspondence, indicating on the facsimile cover sheet "Amendment As Previously Filed." A copy of the facsimile confirmation cover sheet showing successful transmission of the facsimile is enclosed.

For the reasons set forth above, it is respectfully requested that the Notice of Abandonment be withdrawn and the Amendment filed on September 22, 2003 be entered.

Respectfully submitted,

RatnerPrestia

  
Lawrence E. Ashery, Reg. No. 34,515  
Attorney for Applicants

LEA/ds

Enclosures: Notice of Abandonment  
Amendment dated September 22, 2003  
Date Stamped Postcard  
Copy of January 8, 2004 Facsimile Confirmation Cover Sheet

Dated: January 15, 2004

P.O. Box 980  
Valley Forge, PA 19482

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January 15, 2004



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United States Patent and Trademark Office  
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,901	02/04/2002	Yoshiho Gotoh	MTS-710US26	5932

7590 01/12/2004

Ratner & Prestia  
500 North Gulph Road  
P.O. Box 980  
Wayne, PA 19482

JAN 14 2004

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
2137	8

DATE MAILED: 01/12/2004

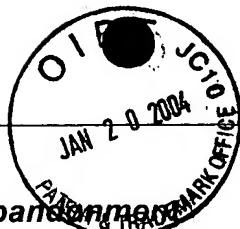
PETITION TO REVERSE (1mo)  
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Notice of Abandonment****Application No.**

10/066,901

**Applicant(s)**

GOTOH ET AL.

**Examiner**

Art Unit

Paul E. Callahan

2134

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

This application is abandoned in view of:

1.  Applicant's failure to timely file a proper reply to the Office letter mailed on 20 June 2003.
  - (a)  A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b)  A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c)  A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d)  No reply has been received.
2.  Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a)  The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b)  The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c)  The issue fee and publication fee, if applicable, has not been received.
3.  Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a)  Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b)  No corrected drawings have been received.
4.  The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5.  The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6.  The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7.  The reason(s) below:

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Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

# MEMORY TRANSMISSION REPORT

PAGE : 001  
 TIME : 01-08-2004 03:34PM  
 TEL NUMBER: 610 407 0701  
 NAME : RatnerPrestia

FILE NUMBER : 982  
 DATE : 01-08 03:28PM  
 TO : 17038729306  
 DOCUMENT PAGES : 007  
 START TIME : 01-08 03:28PM  
 END TIME : 01-08 03:33PM  
 SENT PAGES : 007  
 STATUS : OK  
 FILE NUMBER : 982

\*\*\* SUCCESSFUL TX NOTICE \*\*\*



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Suite 265  
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 5100 Tilghman Street  
 Allentown, PA 18104  
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## FACSIMILE COVER SHEET

DATE: January 8, 2004  
 TIME: \_\_\_\_\_

OUR REF.: MTS-710 US26  
 YOUR REF.: 10/066,901

TO:	CENTRALIZED FAX
COMPANY:	United States Patent and Trademark Office
FROM:	Lawrence E. Ashery
FAX TELEPHONE:	(703) 872-9306
OFFICE TELEPHONE:	
TITLE OF DOCUMENT:	Amendment

Total Number of Pages: 7 (Including this form)

### COMMENTS

AMENDMENT AS PREVIOUSLY FILED

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## FACSIMILE COVER SHEET

DATE: January 8, 2004 OUR REF.: MTS-710 US26

TIME: \_\_\_\_\_ YOUR REF.: 10/066,901

TO:	CENTRALIZED FAX
COMPANY:	United States Patent and Trademark Office
FROM:	Lawrence E. Ashery
FAX TELEPHONE:	(703) 872-9306
OFFICE TELEPHONE:	
TITLE OF DOCUMENT:	Amendment

Total Number of Pages: 7 (including this form)

### COMMENTS

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Date: SEPT 22 2003

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Please acknowledge receipt of the document(s) described below by imprinting the Patents & Trademark Office "date-stamp" hereon and returning this card to the addressee on the reverse side.

FILE NO.: MTS 710 U.S. 26 FEE DUE? YES or NO AMT. ENCLD. \$ 0

NAME: J. G. T. C. H. ET AL.

Specification ( 14 pp.)  Drawing(s) ( 1 pp.)  
 IDS & PTO 1449 ( 1 pp.)  Copy of 1 Reference(s)  
 Copy of Search Report  Form 1390 + copy  
 Claim to Right of Priority  Priority Document(s) 1 SEP 25 2003  
 Response to Missing Parts  Copy of Formalities Letter  
 Declaration & POA ( 1 pp.)  Certificate of Express Mail  
 Petition for Ext. of Time  Assignment & Form 1595 1 COPY ( 1 pp.)  
 Utility Transmittal  Fee Transmittal + copy  
 Amendment/Response ( 4 pp.)  Preliminary Amendment ( 1 pp.)  
 Issue Fee/Publication Fee  Transmittal Form  
 10/066,901

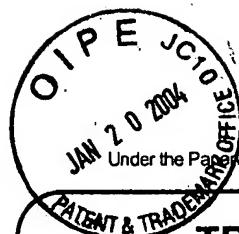
Serial No.: 10/066,901

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PTO/SB/21 (05-03) (AW 07-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 5

Application Number	10/066,901
Filing Date	February 4, 2002
First Named Inventor	Y. Gotoh
Art Unit	2134
Examiner Name	Paul E. Callahan
Attorney Docket No.	MTS-710US26

### ENCLOSURES (Check all that apply)

- Fee Transmittal Form
  - Fee Attached
- Amendment/Reply
  - After Final
  - Affidavits/Declaration(s)
- Extension of Time Request
- Express Abandonment Request
- Information Disclosure Statement
- Certified Copy of Priority Document(s)
- Response to Missing Parts/  
Incomplete Application
- Response to Missing Parts under  
37 CFR 1.52 or 1.53

- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a  
Provisional Application
- Power of Attorney, Revocation,  
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Remarks:

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### SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual	Lawrence E. Ashery	Registration No. (Attorney/Agent)	34, 515
Signature			
Date	September 22, 2003		

### CERTIFICATE OF TRANSMISSION / MAILING

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September 22, 2003

Name (Print/Type)	Lawrence E. Ashery	Date	September 22, 2003
Signature			

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments or the amount of time you require to complete this form and/or suggestions for P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.

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Appln. No.: 10/066,901

Amendment Dated September 22, 2003  
Reply to Office Action of June 20, 2003



MTS-710US26

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. No: 10/066,901  
Applicant: Y. Gotoh et al.  
Filed: February 4, 2002  
Title: OPTICAL DISK, AN OPTICAL DISK BARCODE FORMING METHOD, AN OPTICAL DISK REPRODUCTION APPARATUS, A MARKING FORMING APPARATUS, A METHOD OF FORMING A LASER MARKING ON AN OPTICAL DISK, AND A METHOD OF MANUFACTURING AN OPTICAL DISK  
TC/A.U.: 2134  
Examiner: Paul E. Callahan  
Confirmation No.: 5932  
Docket No.: MTS-710US26

**AMENDMENT**

Mail Stop Non-Fee Amendmet  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Action dated June 20, 2003, please amend the above-identified application as follows:

- Amendments to the Specification** begin on page \_\_\_\_\_ of this paper.
- Amendments to the Claims** are reflected in the listing of claims which begins on page **2** of this paper.
- Amendments to the Drawings** begin on page \_\_\_\_\_ of this paper and include an attached replacement sheet(s).
- Amendments to the Abstract** are on page \_\_\_\_\_ of this paper. A clean version of the Abstract is on page \_\_\_\_\_ of this paper.
- Remarks/Arguments** begin on page **3** of this paper.

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**Amendments to the Claims:** This listing of claims will replace all prior versions, and listings, of claims in the application

**Listing of Claims:**

**Claims 1-35 (canceled)**

36. (Currently Amended) An optical disk, comprising:

an information recording area;

a barcode-like mark;

an identifier for indicating whether or not said barcode-like mark is present on said optical disk, ~~and~~

said barcode-like mark including a plurality of bars, each of said bars extending in a radial direction, ~~and~~

wherein said identifier is provided in the information recording area.

37. (Previously Presented) An optical disk according to claim 36, wherein

an identifier which indicates whether the barcode-like marks are present or not, is provided in the control data area of information recording area.

38. (New) An optical disk, comprising:

a barcode-like mark;

an identifier on said optical disk and separate from said barcode-like mark for indicating whether or not said barcode-like mark is present on said optical disk, and

said barcode-like mark including a plurality of bars, each of said bars extending in a radial direction.

**Remarks/Arguments:**

Claims 36 and 37 have been rejected under obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,052,465. Furthermore, claims 36 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,706,047 (Lentz et al.) in view of U.S. Patent No. 3,752,961 (Torrey) and Official Notice. It is respectfully submitted, however, that these claims are patentable over the art of records for the reasons set forth below.

Applicants' invention, as recited by claim 36, includes a feature which is neither disclosed nor suggested by the art of record, namely:

...an information recording area. . .

an identifier for indicating whether or not said barcode-like mark is present on said optical disk. . .

said identifier is provided in the information recording area

This feature is supported by the originally filed application at page 3, lines 1-5. No new matter has been added.

This feature is not recited in claims 1 and 2 of U.S. Patent No. 6,052,465. Therefore, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

In addition, neither Lentz nor Torrey disclose this feature. The Official Action acknowledges that "Lentz does not teach inclusion of an identifier." Furthermore, the Official Action acknowledges that "Torrey does not teach the use of an identifier." Thus, even by combining Lentz and Torrey, Applicants' claim 36 does not result. While the Official Action takes official notice "that the use of a control data area of a disk to write identifiers is a step that is old and well known in the art," no reference has been placed on the record which discloses the feature of an identifier which indicates presence or absence of a barcode. As this feature is neither disclosed nor suggested by the art of record, claim 36 is patentable over the art of record.

Claim 37 is also patentable by virtue of its dependency on allowable claim 36.

Appn. No.: 10/066,901  
Amendment Dated September 22, 2003  
Reply to Office Action of June 20, 2003

MTS-710US26

Applicants have added new claim 38. Claim 38 recites the feature of:

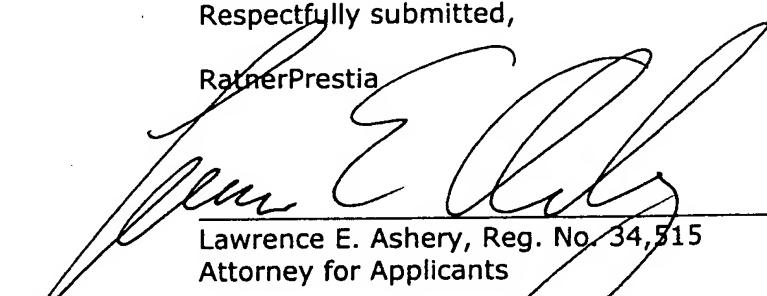
... an identifier on said optical disk and separate from said barcode-like mark for indicating whether or not said barcode-like mark is present on said optical disk

Again, this feature is neither disclosed nor suggested by the art of record. Accordingly, claim 38 is patentable over the art of record.

For the reasons set forth above, the above-identified application is in condition for allowance which action is respectfully requested.

Respectfully submitted,

RatherPrestia

  
Lawrence E. Ashery, Reg. No. 34,515  
Attorney for Applicants

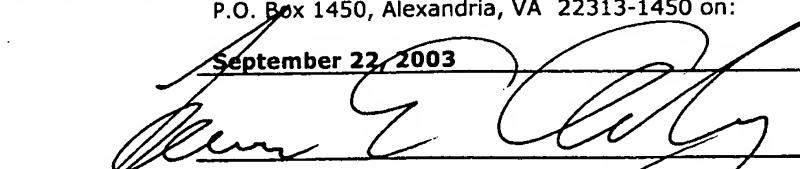
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Dated: September 22, 2003

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September 22, 2003

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